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10/598,994

09/18/2006

Marc Peuker

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12/24/2008

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EXAMINER

PAGAN, JENINE MARIE

ART UNIT

PAPER NUMBER

3728

NOTIFICATION DATE

DELIVERY MODE

12/24/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/598,994 | <b>Applicant(s)</b><br>PEUKER ET AL. |  |
|                              | <b>Examiner</b><br>JENINE M. PAGAN   | <b>Art Unit</b><br>3728              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006 and 05 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 55-90 is/are pending in the application.
- 4a) Of the above claim(s) 65-72, 74-83, 85 and 88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 55-64, 73, 84, 86, 87, 89 and 90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/29/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's election without traverse of Species I Figures 1-6 and 8-9 claims 55-64,68,73,84,86,87,89,and 90 in the reply filed on 12/05/2008 is acknowledged. Claims 65-67,69-72,74-83,85 and 88 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/05/2008.

2. Claim 68 is withdrawn due to its dependency on withdrawn claim 65. The Examiner assumes a typographical error when electing claim 86 instead of claim 85 due to the fact claim 86 refers to species not elected and claim 85 refers to the seal which is mentioned in the species elected and the previous claims elected.

3. It is noted that the claims as presented are directed to a product and method of forming the product. As currently presented, the method is the mere assembly of the product and its examination in conjunction with the product does not represent a serious burden at this time; therefore, no restriction is required. However, if subsequent amendments to the claims result in diverging subject matter and searches between the claimed inventions, the examiner reserves the right to restrict at that time.

### ***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

5. The information disclosure statement (IDS) submitted on 12/29/2006 is being considered by the examiner.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 84 recites the limitation "transparent appearance of the package an orange coloring to filter blue light" in lines 1 and 2 in claim 84. There is insufficient antecedent basis for this limitation in the claim. Where is it applied to what pieces and what places? Is the material transparent?

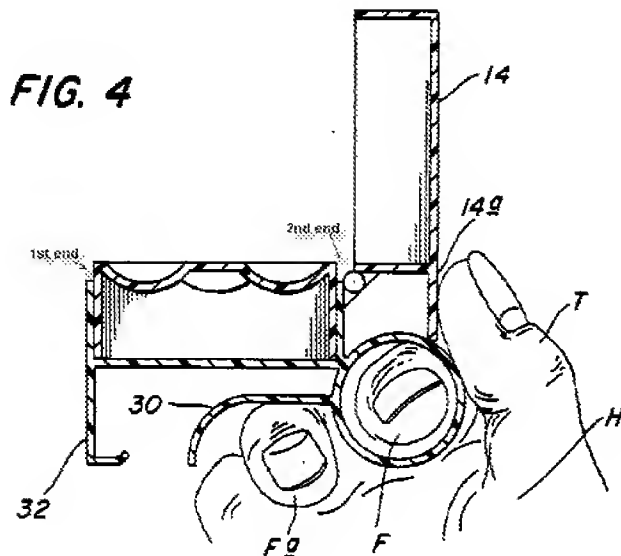
8. Claim 90 recites an improper Markush group. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). It is improper to use the term "comprising" instead of "consisting of." *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931). See MPEP 2173.05(h).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.



10. Claims 55-59, 61, 62, 84, 87, 89 and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by McGarrigle (US 5,249,963).

**Claim 55:** McGarrigle discloses a package assembly for storing and delivering dental substance:

- at least one container 10 comprising a base 12 and a lid 14; and
- at least one hinge 16/18 connecting the base 12 and the lid 14;
- wherein the base 12 and the lid 14 comprise first 14a and second 26/30 levers, the first 14a and second 26/30 levers are provided at the container 10 essentially on the side of the hinge 16/18 with their free ends extending essentially in a direction away from the hinge 16/18; and wherein the container 10 can be opened or the lid 14 can be removed from the base 12 by moving the ends of the first 14a and second 26/30 levers towards each other

**Claim 56:** McGarrigle discloses a package assembly for storing and delivering dental substance:

- the hinge 16/18 is provided between the first 14a and second 26/30 lever

**Claim 57:** McGarrigle discloses a package assembly for storing and delivering dental substance (see figure above and Col 2:42-47):

- the container 10 comprises a first end next to the base 12 and a second end next to the lid 14, which is adapted for air-tight closing of the container at the second end

(When the lid closes down on the base the container is closed preventing air from entering the container as seen in Figure 3)

**Claim 58:** McGarrigle discloses a package assembly for storing and delivering dental substance:

- the end of the second lever 26/30 is bent in a direction away from the first lever 14a (Fig. 3)

**Claim 59:** McGarrigle discloses a package assembly for storing and delivering dental substance (Col 2:39-40):

- the container 10 is pre-filled with at least one dental substance

**Claim 61:** McGarrigle discloses a package assembly for storing and delivering dental substance:

- the base 12 and/or the lid 14 are manufactured with an opening for filling the container 10 after manufacturing and for sealing with a seal

(When the container is manufactured and filled with substance the lid closes down on the base and the container is sealed together as seen in Figure 3)

**Claim 62:** McGarrigle discloses a package assembly for storing and delivering dental substance (see figure above):

- the container 10 is sealed with a seal at the first end

(When the lid closes down on the base the container is sealed together as seen in Figure 3)

**Claim 84:** McGarrigle discloses a package assembly for storing and delivering dental substance:

- for transparent appearance of the package an orange coloring to filter blue light is used (Col 2:42-47)

**Claim 55:** McGarrigle discloses a package assembly for storing and delivering dental substance:

**Claim 87:** McGarrigle discloses a method of providing dental substance according to claims 55-59, 61, 62 and 84 (Figure 4):

- opening the initial closed package assembly 10 by pressing the two levers 14a/26/30 together, and
- taking the substance (Col 2:39-40) out of the container 10

**Claim 89:** McGarrigle discloses a method of providing dental substance according to claim 87, comprising after the second point furthers the step:

- closing the container 10 by pressing the lid 14 onto the container (Fig. 4)

Regarding to claims 87 and 89, under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the

prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). MPEP 2112.02

**Claim 90:** McGarrigle discloses a package assembly for storing and delivering dental substance:

- comprising at least one of the following materials: bonding materials (Col 2:39-40)

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 60 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarrigle (US 5,249,963) in view of McDevitt et al. (US 5,204,130).

**Claim 60:** McGarrigle discloses the claimed invention as stated above in claim 55 except:

- the base, the lid and the hinge are integrally molded

However McDevitt discloses:

- the base 20, the lid 24 and the hinge 26 are integrally molded (Col 3:8-9,17-18-19)



It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the base, lid and hinge integrally molded, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

**Claim 87:** McGarrigle discloses the claimed invention as stated above in claim 55 and 60, the method:

- opening the initial closed package assembly 10 by pressing the two levers 14a/26/30 together, and
- taking the substance (Col 2:39-40) out of the container 1

13. Claims 63-64, 85 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarrigle (US 5,249,963) in view of Keaveney et al. (US 5,938,018).

**Claim 63:** McGarrigle discloses the claimed invention as stated above in claim 55 and 62 except:

- the seal is a foil and/or a plug and/or part of the base

However Keaveney discloses:

- the seal 24 is part of the base 12

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the seal part of the base as taught by Keaveney, since Keaveney suggests at column 3 line 52-54 that such a modification would preserve the aroma inside of the container.

**Claim 64:** McGarrigle discloses the claimed invention as stated above in claim 55 and 62 except:

- the seal is a foil and/or a plug and/or part of the lid

However Keaveney discloses:

- the seal 24 is part of the lid 14

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the seal part of the lid as taught by Keaveney, since Keaveney suggests at column 3 line 58-63 that such a modification would preserve the aroma inside of the container.

**Claim 85:** McGarrigle discloses the claimed invention as stated above in claim 55 except:

- the container is sealed with a foil

However Keaveney discloses:

- the container is sealed with a foil

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the container sealed with foil as taught by Keaveney, since Keaveney suggests at column 2 line 52-54 that such a modification would preserve the aroma inside of the container.

**Claim 87:** McGarrigle discloses the claimed invention as stated above in claim 55, 63, 64 and 85, the method:

- opening the initial closed package assembly 10 by pressing the two levers 14a/26/30 together, and

- taking the substance (Col 2:39-40) out of the container 1

14. Claims 73 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarrigle (US 5,249,963) in view of Discko, Jr. (US 5,660,273).

**Claim 73:** McGarrigle discloses the claimed invention as stated above in claim 55 except McGarrigle does not specifically disclose:

- the package comprises a disposable applicator

However Discko discloses:

- the package 30 comprises a disposable applicator 20

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the package of McGarrigle include a disposable applicator as taught by Discko, since Discko states at column 3 line 50-60 that such a modification would allow the user to use the material such as bonding agents located inside of the container.

**Claim 87:** McGarrigle discloses the claimed invention as stated above in claim 55 and 73, the method:

- opening the initial closed package assembly 10 by pressing the two levers 14a/26/30 together, and
- taking the substance (Col 2:39-40) out of the container 1

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENINE M. PAGAN whose telephone number is (571)270-3216. The examiner can normally be reached on Monday - Thursday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Gregory Pickett/  
Primary Examiner, Art Unit 3728

/Jenine M Pagan/  
Examiner, Art Unit 3728